

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CAROLINE M. YLITALO, MARIO A. PEREZ, EDWARD G. STEWART,
and PATRICK D. HYDE

MAILED

MAY 22 2003

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2003-0578
Application No. 09/114,027

ON BRIEF

Before GARRIS, TIMM, and JEFFREY T. SMITH, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

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DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1-20 which are all of the claims in the application. On pages 1 and 2 of the answer, the Examiner has indicated that the rejection of claims 3-6, 11-14 and 17-20 has been dropped and that these claims are now objected to but otherwise allowable. Accordingly, the only claims remaining before us on this appeal are claims 1, 2, 7-10, 15 and 16.

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The subject matter on appeal relates to a pressure sensitive adhesive composition comprising a thermoplastic polymer having substantially no epoxy-binding functions or ester functions and a photocured epoxy. This appealed subject matter is adequately represented by independent claim 1 which reads as follows:

1. A pressure sensitive adhesive composition comprising:
 - a) 75 to 99.9 weight percent of a tackified thermoplastic polymer component comprising
 - 1) 1-99 weight percent of a thermoplastic polymer having substantially no epoxy-binding functions or ester functions, and
 - 2) 1-99 weight percent of a tackifier; and
 - b) 0.1 to 25 weight percent of an epoxy component comprising a photocured epoxy.

The references set forth below are relied upon by the Examiner as evidence of obviousness:

JP Derwent Abstract XP 02118060 (Japanese '060 Abstract) May 27, 1994

JP Derwent Abstract XP 02118059 (Japanese '059 Abstract) August 21, 1997

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Claims 1, 2, 7-10, 15 and 16, which are all of the claims now on appeal, stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Japanese '060 Abstract or the Japanese '059 Abstract.¹

Rather than reiterate the respective positions advocated by the Appellants and by the Examiner concerning the above noted rejections, we refer to the brief and to the answer for a complete exposition thereof.

OPINION

For the reasons set forth in the answer and below, we will sustain each of these rejections.

Both of the applied references disclose an adhesive composition comprising a thermoplastic polymer, a tackifier and an epoxy. Further, each reference discloses several types of acceptable thermoplastic polymers including types which the Appellants have disclosed as having substantially no epoxy-binding functions or ester functions as required by appealed claim 1. For

¹ As indicated on page 4 of the brief, the above rejected claims will stand or fall together. As a consequence, in assessing the merits of the rejections before us, we will focus on claim 1 which is the sole independent claim on appeal. See 37 CFR § 1.192(c)(7)(2001).

example, as correctly pointed out by the Examiner, the second paragraph on page 3 of the Appellants' specification teaches using polybutadienes and polystyrenes as the here claimed "thermoplastic polymer having substantially no epoxy-binding functions or ester functions" (claim 1), and these polymers are among those which are taught to be acceptable in the adhesive compositions of the applied references.

In light of the foregoing, we share the Examiner's conclusion that it would have been obvious for one with ordinary skill in the art to formulate the adhesive compositions of the Japanese '060 Abstract and the Japanese '059 Abstract by using thermoplastic polymers such as polybutadienes and polystyrenes respectively since these polymers are disclosed in the aforementioned references as being acceptable. Similarly, it would have been obvious for the artisan to formulate the respective adhesive compositions of the applied references by using an epoxy component since each reference expressly teaches that an epoxy (as well as a tackifier) is an acceptable ingredient of the adhesive compositions of the references. Finally, we agree with the Examiner that it would have been obvious to determine workable concentration ranges for the adhesive ingredients disclosed in these references (e.g., see

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In re Boesch, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980)), and the Appellants do not argue otherwise.

In support of their nonobviousness position, the Appellants argue that neither of the applied references discloses the claim 1 limitation of a thermoplastic polymer "having substantially no epoxy-binding functions or ester functions". According to the Appellants, these references teach away from the here claimed invention because the thermoplastic polymers of these references include certain polymers which actually possess the functions excluded by appealed claim 1. This argument is unpersuasive.

The Appellants last mentioned point, even if correct, does not forestall an obviousness conclusion. This is because the thermoplastic polymers of the applied references also include those which have substantially no epoxy-binding functions or ester functions as required by the independent claim on appeal. Thus, even though the reference polymers may include those which actually possess the functions excluded by this claim, it would have been obvious to formulate the adhesive compositions of the applied references using any of the thermoplastic polymers disclosed therein including those which are expressly taught by the Appellants as possessing the function excluding property defined

by appealed claim 1. Stated otherwise, the fact that these last mentioned thermoplastic polymers are not highlighted by the applied references does not forestall an obviousness conclusion since this is not required under § 103. See Merck & Co. Inc. v. Biocraft Labs., 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir.), cert denied, 493 U.S. 975 (1989).

The Appellants also argue that the Examiner's § 103 rejections are improper because neither of the applied references discloses an epoxy component which is "photocured" as recited in appealed claim 1. It is appropriate to here reiterate the Examiner's correct point that the claim 1 language which describes the recited epoxy as "photocured" constitutes product-by-process language. With respect to such language, it is well settled that patentability is determined by the product rather than by the process via which the product is made. In re Thorpe, 777 F.2d 695, 697-98, 227 USPQ 964, 966 (Fed. Cir. 1985).

On the record before us, it is proper to regard the "photocured epoxy" of appealed claim 1 as being indistinguishable from the epoxies of the applied references which are, for example, thermally cured. In this regard, it is significant that the Appellants expressly teach that their epoxies may be photocured or thermally cured (e.g., see lines 1-14 on specification page 6),

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thereby indicating that the epoxies resulting from either curing technique are acceptable and thus seemingly indistinguishable.

Where, as here, the claimed and prior art products (i.e., the epoxies under consideration) are identical or substantially identical, or are produced by identical or substantially identical processes, the Patent and Trademark Office can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product. Whether the rejection is based on "inherency" under 35 U.S.C. § 102, on "prima facie obviousness" under 35 U.S.C. § 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the inability of the Patent and Trademark Office to manufacture products or to obtain and compare prior art products. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977).

The Appellants have advanced no proofs in the record of this appeal to support their burden of showing that the epoxies of the applied references do not actually possess the same characteristics as the photocured epoxy of appealed claim 1. For this reason, we are constrained to consider the argument under review as unconvincing. Id.

Finally, the Appellants argue that no basis exists for the Examiner's position that the "self-adhesive" of the Japanese '060

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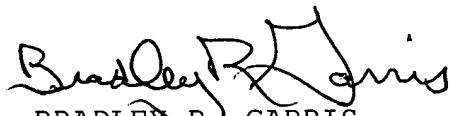
abstract corresponds to a "pressure sensitive adhesive" as recited in appealed claim 1. We cannot agree. As discussed above and in the answer, the compositions encompassed by the Japanese '060 Abstract include those which have the same ingredients as recited in the Appellants' claim 1. It is proper, therefore, to consider the applied reference composition and the here claimed composition to possess the same properties including the property of being pressure sensitive. Again, it is fair that the Appellants should carry the burden of showing otherwise due to the inability of the Patent and Trademark Office to manufacture products or to obtain and compare prior art products. In re Best, 562 F.2d at 1255, 195 USPQ at 433-34. The Appellants have not carried their burden of showing that the "self-adhesive" of the Japanese '060 Abstract does not actually possess the pressure sensitive property of the here claimed adhesive.

For the above stated reasons and those expressed in the answer, we hereby sustain the Examiner's § 103 rejections of claims 1, 2, 7-10, 15 and 16 as being unpatentable over the Japanese '060 Abstract or the Japanese '059 Abstract.

The decision of the Examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

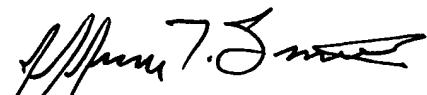
AFFIRMED



BRADLEY R. GARRIS)
Administrative Patent Judge)
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CATHERINE TIMM)
Administrative Patent Judge)
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JEFFREY T. SMITH)
Administrative Patent Judge)
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